

REMARKS

In the September 14, 2004 Office Action, claims 1-17 have been rejected as either anticipated by or obvious over United Kingdom Pat. No. 2,327,565 granted to International Business Machines Corp. ("the IBM patent"). The rejected claims have either been cancelled or amended herein in order to more clearly reflect the present invention. The claims in their amended form recite elements not disclosed or suggested by the IBM patent and are therefore allowable over the reference.

The disclosure of the IBM patent is significantly different from the invention as claimed. Amended claim 1 is directed to an apparatus for initiating a document download having a mechanical activation switch that is linked to at least one of the apparatus memory and the apparatus wireless transmitter. Accordingly, document download can be initiated by activating the mechanical activation switch on the apparatus. This is in contrast to the IBM patent which requires use of dedicated handheld terminals 70-90 to initiate the interrogation of the tagging devices 100-130 and to communicate with a base station 50 connected to the Internet. See, e.g., the IBM patent, p. 6, lines 19-26; p. 6, lines 33-35. The IBM patent's tagging devices 100-130 are not taught to have a mechanical activation switch or any equivalent, and in fact are taught to be passive devices that do not communicate information unless first interrogated by the dedicated terminals 70-90. *Id.* Amended claim 1 thereby claims a structure not disclosed or suggested by the IBM patent and is allowable over it.

Claims 2-6 depend from claim 1 and are allowable over the IBM patent for the same reasons as are that claim in addition to other reasons. Claim 5, for example, recites that the download instructions include instructions for printing a document contained in the data file. The IBM patent fails to disclose or suggest printing of a document, but instead limits its output to display of information on the handheld terminal 70-90 or audio output. See, e.g., the IBM patent, p. 2, line 38- p. 3, line 2; p. 7, lines 4-6. Further, the handheld terminal 70-90 is taught to be portable and is not disclosed to be connected to a printer. This is consistent with what the IBM patent discloses its system is

useful for: as an aid to shoppers in a store, as a guide for visitors to a museum, or as a device for showing train timetables. IBM patent, p. 8, line 32 - p. 9, line 23. In all of these applications, the handheld terminals are useful for a user to initiate interrogation and to display final output data. Applications of the presently claimed invention, on the other hand, include (but are not limited to) printing voluminous product manuals for consumer products that have been purchased and are in use at home. See, p. 8, line 5-25. In such applications, the requirement of the dedicated handheld terminal 70-90 as taught by the IBM patent would not be desirable, and instead a self-contained apparatus as claimed by claims 1-12 would be preferred.

Claim 6 has been amended to more clearly reflect that the wireless protocol has an operating range of no more than about 3 meters. The IBM patent fails to disclose this range. It is noted that the examiner has cited p. 6, lines 25-27 as disclosing the recited range of claim 6. This portion of the IBM patent, however, fails to disclose an operating range of no more than about 3 meters as amended claim 6 recites.

Claims 8 and 10 have been cancelled. Claims 9 and 11 depend from claim 1 and are allowable over the IBM reference for the same reasons as are claim 1 as well as for additional reasons. Claim 9, for example, further requires that the apparatus has a shell with a passage for operable access to the mechanical activation switch and that the shell have attachment means for attaching the shell to a product. The IBM patent fails to teach this claimed structure. The IBM patent makes no disclosure of its tagging devices 100-130 having a mechanical activation switch, and in fact teaches away from this in that the tagging devices 100-130 are passive devices that must be first interrogated by the dedicated terminals 70-90. The IBM patent further fails to teach a shell or a shell passage for operable access to a mechanical activation switch. For this and other reasons, claim 9 is allowable over the IBM patent. Claim 12 has been amended to recite a mechanical activation switch that penetrates the shell of the apparatus. The IBM patent fails to disclose or suggest this structure, with the result that claim 12 is allowable.

Claim 13 has been amended to recite a computer program product that detects a prompt from a mechanical activation switch that is linked to a memory. As

discussed herein above, the IBM patent fails to teach such a computer program product, and instead discloses a program product that detects an interrogation signal sent by the dedicated handheld terminal 70-90.

Claim 14 depends from claim 13 and is allowable over the IBM patent for the same reasons as are claim 13 in addition to other reasons. Claim 14, for example, requires that the program product instructions cause the transmitter to transmit the download instructions only within a range of less than about 3 meters. The IBM patent fails to disclose this limitation. Claims 15-16 have been cancelled.

Claim 17 has been amended to more clearly claim one exemplary embodiment of the present invention, and as amended includes several elements not taught by the IBM patent. For example, amended claim 17 requires a program product that detects a prompt from a mechanical activation switch that is linked to the memory. Claim 17 also requires that the program product instructions cause document download instructions to be retrieved that include instructions for execution by a printer connected to a network that cause the printer to locate a data file on the network and print a document corresponding to the data file. The IBM patent discloses a substantially different computer program product. The computer program product(s) disclosed by the IBM patent, for instance, only facilitates more complicated communication first from the handheld terminal 70-90 to a tagging device 100-130, then back to the handheld terminal 70-90, then to a base station 50 and the Internet, then back to the handheld terminal 70-90 for display. No printing of a document is disclosed, much less the convenient communication directly with a printer as is claimed by claim 17.

Several new claims have been presented for consideration and are believed allowable. New claim 18 depends from claim 1 and recites that the mechanical activation switch has one of a plurality of different structures. The IBM patent fails to disclose the claimed mechanical activation switch at all, much less the particular structure of claim 18. Claim 19 depends from claim 1 and recites that the document download instructions cause a printer connected to a network to download and print a document, and that the wireless transmitter is configured to transmit the document download instructions to the

printer only when the printer is within a range of about 3 meters. This claimed invention embodiment thereby provides an apparatus that can be used to cause a document from a network to be printed, and further does not require an intermediate handheld terminal 70-90 or base station 50. The elements of claim 19 are not taught or suggested by the IBM patent, with the result that it is allowable.

New claims 20 and 21 depend from amended claim 13 and are allowable for the same reasons as are that claim, in addition to other reasons. New claim 20 recites that the computer program product cause the apparatus to communicate directly with a printer connected to a network and to cause the printer to print a document retrieved from the network. Accordingly, no intermediate handheld terminal 70-90 or base station 50 is required. Claim 21 limits communication of the document download instructions by the apparatus to a range of no more than about 3 meters. Claims 20 and 21 are therefore allowable.

It is believed that all remaining claims as amended overcome the rejections of the September 14 Office Action and should be allowed. Timely allowance is requested. Should the Examiner feel that there are issues remaining for attention before allowance can be granted, the favor of a telephone conference with Applicant's undersigned Attorney is respectfully requested.

Respectfully submitted,

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December 8, 2004

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